Office Supreme Court, U.S.
FILED
JUL 13 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM 1963

No. [redacted] 176

TECHNOGRAPH PRINTED CIRCUITS, LTD., and TECHNOGRAPH PRINTED ELECTRONICS, INCORPORATED,
Petitioners,

v.

THE BENDIX CORPORATION, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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July 13, 1964

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the District Court is reported at 218 F. Supp. 1 (1963) and is reproduced in Volume I, pages 1a-160a of the Appendix to Petitioner's Brief in the Court below (I: 1a-160a). The *per curiam* affirming opinion of the Court below is reported at 327 F. 2d 497 (1964) and appears in the Appendix to the Petition.

JURISDICTION

The jurisdictional requisites are adequately set forth in the Petition.

QUESTION PRESENTED

Whether this petitioner can obtain a *second** review of a baseless argument rejected by the Court below merely by

(1) appending to that selfsame argument a reference to the due process clause of the Fifth Amendment, and

(2) conveniently ignoring in the Petition the mass of *objective* evidence before the Court below, fully supporting the holding that the claims in suit are invalid as obvious.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

The constitutional provisions and statutes both *actually* involved and *assertedly* involved are set forth at pages 3-4 of the Petition.

STATEMENT OF THE CASE

Petitioners sued respondent for infringment of certain claims of three Eisler patents, all of which stem from a single original application. All claims of the patents in suit recite *methods* for manufacturing "printed circuits". In his specifications, Eisler necessarily acknowledged that the method steps recited were known to and borrowed from the graphic arts. (I: 185a, col. 1, line 50 to col. 2, line 15)

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* Emphasis added unless otherwise indicated.

After an extensive trial, during which the District Court heard the evidence of twenty-seven witnesses and received twenty depositions of additional witnesses, judgment was rendered for respondent. The District Court's decision was *not* solely (or even "primarily") based on anticipation of the claims by the Stevens and Dallas application as asserted by petitioners, but on *each* of the following grounds:

> (1) all of the asserted claims of Eisler patent 2,441,960 and claim 5 of Eisler patent 2,706,697 are invalid because they define inoperative procedures;
>
> (2) Eisler reissue patent 24,165 is invalid for double patenting over the '960 patent;
>
> (3) the claims in suit are invalid as anticipated by the prior art;
>
> (4) the claims in suit are invalid as defining subject matter which is obvious in view of the prior art;
>
> (5) the indefiniteness of many of the claims in suit which supported the finding of invalidity; and
>
> (6) none of the involved claims was infringed by defendant.

The District Court's findings of invalidity were based on:

> (1) a detailed consideration of the prosecution histories of the applications maturing into the patents in suit, including the disclosure of each of 15 different prior patents cited by the Patent Office. (I: 14a-52a);

(2) a detailed consideration of some 15 additional prior patents and other prior art *not cited* by the Patent Office against the Eisler applications and found by the Court *to be more pertinent* than the cited art (I: 57a-88a). This consideration included the detailed testimony of defendant's expert witness (Vol. 1, pp. 157-178 of Appendix to Brief of Defendant in the Court below*) comparing the methods advanced as invention by Eisler to the methods described in the prior art references;

(3) the testimony of various witnesses as to the commercial use and practicality of the methods disclosed by the prior patents (I: 63a-64a, 74a, 83a);

(4) a thorough analysis of the testimony of witnesses of both parties and copious printed evidence concerning the meaning of the critical terms of the claims in suit (I: 88a-101a);

(5) testimony of various *independent* developers of the same methods recited by the claims of the patents in suit, each of whom testified that, when faced with a need for printed circuitry, he too independently "borrowed" the hallowed techniques of the graphic arts (I: 121a-122a, 131a-132a); and

(6) testimony of the Director of Research of a pioneer and leading supplier of the raw material *essential* to the claimed methods (a metal-coated insulating material) that the commercial success of the processes used by defendant is attributable to the development of a satisfactory raw material rather than to any disclosure of Eisler (I: 121a-122a).

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* Hereinafter cited as (D-I: —).

In the Court of Appeals, petitioner advanced various Fourth Circuit decisions espousing the "objective test" of invention and argued, as here, that

> "Defendant has the burden of *proving* invalidity; 35 U.S.C. 282; but its brief cites no *evidence* which proves, or even tends to prove, that the subject matter of any claim in suit, taken as a whole, was obvious in 1943 to a person of ordinary skill in the art." [Emphasis by petitioners.] (Petitioners' Reply Brief, pp. 20, 21)

But respondent's (defendant's) brief *did* delineate the objective evidence of obviousness with which the record is replete. Significantly, the Court of Appeals for the Fourth Circuit, long a proponent of the objective test of invention, held:

> "After careful consideration of the record, the arguments and the briefs of counsel, we are persuaded that the patent claims are invalid for obviousness in the light of the prior art for the reasons fully discussed in the opinion of the District Court."

ARGUMENT

I.

The "Questions Presented" Are Not Raised by the Record

The "questions presented" by the Petition are based solely on petitioners' specious assertion that the record in this case is devoid of proof of the obviousness of the subject matter of the claims in suit. Rather than to belabor all of the objective evidence present in the record upon which the decision of the Courts below was soundly based, representative samples will be presented.

Initially, the record contains the detailed testimony of defendant's expert in which the disclosures of the

cited references were explained to the District Court and the marked similarity, and in many cases the identity, of teaching between such references and the claimed invention was pointed out. For example, and in the words of the District Court:

> "When asked to compare these processes [disclosed by Stevens and Dallas] with Basist or Kaufman, defendant's expert without objection replied that they are the same. Asked to compare them with the printing and etching steps found in '960, he again replied, without objection:
>
> > 'They are the same. However, Stevens and Dallas go into more detail and are more complete in the description of the etching process and in the resist application techniques.'
>
> With this appraisal, the court unqualifiedly agrees." (I:63a)

With respect to the O'Connell reference, defendant's expert testified:

> "Q. Now, again comparing processes, what distinction if any do you find between the process set forth which you have read into the record, which appears as the bridging paragraph of the two columns on page 2 of O'Connell, and the process steps set forth in Eisler specification '960 with respect to printing and etching to produce electric components?
>
> "A. They are the same. The sequence of steps, the etching away all of the metal through to the substrate, and, in particular, going down to line 15 of column 2, on page 2, 'This device appears to be also useful as a substitute for the usual aerial or antenna,' and the coil, No. 31, in figure 7, of the Eisler specification, as I remember it, is said to be usable in the antenna circuit of that radio. So, we are in the same field of endeavor with an identical process." (D-I: 166)

Any more objective proof of obviousness than such testimony would be hard to imagine. In addition to the expert testimony with respect to the O'Connell patent, Shortt, the president of the American plaintiff, *admitted the obviousness* of the claimed printing and etching technique of Eisler in view of O'Connell's teaching. The following testimony is significant:

> "Q. Would the knowledge of how Defendant's Exhibit 317 [the electrostatic shield or antenna disclosed by O'Connell] is made suggest anything to you about how to make Defendant's Exhibit 319 [the inductance coil made during *inter partes* tests by the Eisler process]?
>
> "A. If someone had told me and showed me that pattern and told me—
>
> "Q. By that pattern do you mean Defendant's Exhibit 317?
>
> "A. Yes.
>
> "Q. All right.
>
> "A. —had been made from a foil clad laminate, had been printed and etched, then I would say there was no reason why you couldn't make that [indicating Defendant's Exhibit 319] by the same process.
>
> "Q. And by that you mean Defendant's Exhibit 319 for identification?
>
> "A. That's right." (D-I: 57)

Witness after witness testified that when a need to produce printed circuitry arose, each, without any knowledge of Eisler, turned to the known graphic arts techniques and were successful in their endeavors. For example, Swiggett, petitioners' primary technical witness, testified on cross-examination:

> "Q. Now isn't it a fact, Mr. Swiggett, that when you took these samples into your laboratory, you just performed the well-known process of plating [printing] and etching which you knew all about?
>
> "A. Yes." (D-I: 7)

Pritikin testified that when first exposed to the problem of producing printed circuitry, he immediately turned to the printing and etching techniques with which he was familiar as the *"obvious"* way of proceeding. (D-I: 94)

It was on the basis of such *objective evidence of obviousness* that the lower Court stated:

> "When the available literature, both patents and publications, not cited, is considered, and also the ability of persons unaware of the alleged inventions to reach the same results by the same means, the court has no hesitation in holding the patents, and the claims in suit, to be invalid." (I: 54a).

For petitioners to urge, on the basis of the record in this case, that the Courts below reached their decisions without the aid of evidence of obviousness is simply incomprehensible. The "questions presented" by petitioners are wholly synthetic—they can not find support in the record of this case.

II.

The Authorities Relied on by Petitioners Do Not Justify the Review Sought

In addition to quoting from and repeatedly citing a decision of this Court refusing to strike down a State statute requiring that a defendant in a criminal case prove a defense of insanity beyond a reasonable doubt (*Leland* v. *Oregon*, 343 U.S. 790 (1952)), petitioners

appear to rely primarily on *Monroe Auto Equipment Co.* v. *Heckethorn Mfg. Co.*, — F. 2d —, 141 USPQ 549 (6th Cir. 1964), and *Bain* v. *The M. A. Hanna Company*, 331 F. 2d 974, (6th Cir. 1964).

Reliance on *Monroe* is based on a statement in the opinion:

> "There was testimony that it would have been obvious to insert a rubber sleeve to prevent the metal-to-metal contact and resultant noise of the spring banging against the shock absorber." (141 USPQ 555)

The implication petitioners seek to draw is that there must be express *testimony* that the claimed invention is obvious, as opposed to *evidence of obviousness*, before a court properly may hold a claim invalid as obvious under 35 U.S.C. 103. But the Court in *Monroe* belies this implication at 141 USPQ 554, stating:

> "Thus what we have in a patent case are three steps: First, a determination of what the prior art was; this involves factual questions. Secondly, there is a determination of what, if any, improvement the patentee has made over the prior art; this will usually turn on expert testimony and therefore is a question of fact. The final step is to determine whether the improvement would have been obvious to one skilled in the art. This requires application of a legal criteria and therefore *is a question of law, fully reviewable by* the appellate court."

Moreover, at 141 USPQ 558 the Court expressly held that claim 14 of patent '235 was invalid for lack of invention over the disclosure of four patents and an S.A.E. Journal article.

Manifestly, the Court of Appeals for the Sixth Circuit did not require *express* testimony of obviousness

in the teeth of its prior decision in *General Motors Corp.* v. *Estate Stove Co.*, 203 F. 2d 912 (6th Cir. 1953), on a petition for rehearing advancing essentially the same argument made by petitioners here. There the court stated:

> "In advancing its argument, appellee submits, at least implicitly, that, under the new Act, the evidence establishing invalidity must consist of the testimony of witnesses, and that the court's finding of invalidity must be sustained by such testimonial evidence. *We find no warrant in the Act for such a conclusion, nor that the function of the court has changed in this regard* since Judge Learned Hand made a memorable declaration in the field of patent law, in Kohn v. Eimer, 265 F. 900, 902 (C.C.A. 2), when he stated: 'At the outset the appellant challenges our right to examine the prior art patents at all, because the appellee called no expert at the trial to explain them. Waterman v. Shipman, 55 F. 982, 987; 5 C.C.A. 371. We have not the slightest wish to minimize the vital importance of expert testimony in patent suits, or to suggest that we are not absolutely dependent upon it within its proper scope; but that scope is often altogether misapprehended, as the appellant has misapprehended it here. Specifications are written to those skilled in the art, among whom judges are not. It therefore becomes necessary, when the terminology of the art is not comprehensible to a lay person, that so much of it as is used in the specifications should be translated into colloquial language; in short, that the judge should understand what the specifications say. This is the only permissible use of expert testimony which we recognize. When the judge has understood the specifications, he cannot avoid the responsibility of deciding himself all questions of infringement and anticipation, and the testimony of experts upon these issues is in-

evitably a burdensome impertinence.'" (203 F. 2d 914-915.)

The same position was more recently taken by the Court of Appeals for the same Sixth Circuit in *Nickerson* v. *Bearfoot Sole Company*, 311 F. 2d 858, 869, 870 (6th Cir. 1963).

Clearly, the Court in *Monroe* was merely requiring that the status of the prior art be determined preliminary to finding whether a patentable advance (if any) over the prior art had been made. The present case is replete with evidence both of the status of the prior art and of the lack of patentable improvement over that prior art.

In *Bain* v. *M. A. Hanna Co., supra,* the Court of Appeals affirmed the holding of the District Court that the patent in suit was *anticipated* and, accordingly, invalid. The court then declined to affirm the holding of *lack of invention* on grounds that "the record does not contain any factual basis for such finding and conclusion." The deficiency of the record in this regard was not delineated. Even if it logically can be accepted that an anticipatory reference under 35 U.S.C. 102 is not also evidence of obviousness under 35 U.S.C. 103, a "factual basis" for a holding of obviousness clearly is presented by the present record.

It is manifest that if the present Petition were granted, it would be the *sufficiency* of the evidence of obviousness *in this case* which would be reviewed, and not the abstract requirement of 35 U.S.C. 103, as urged by petitioners.

III.

There is no Legitimate Issue of Due Process Raised by This Petition

The record in this case provides overwhelming evidence of the obviousness of the claims in suit. Accordingly, the affirmance of the holding of invalidity on that ground was amply justified. Since 35 U.S.C. 103 clearly is satisfied, due process has been observed.

CONCLUSION

In *Magnum Import Co.* v. *DeSpoturno Coty*, 262 U.S. 159, 163 (1922), Chief Justice Taft stated:

> "The jurisdiction [by certiorari] was not conferred upon this court merely to give the defeated party in the circuit court of appeals another hearing."

"Another hearing" would be the only result of the granting of the Petition in this case.

The Petition should be denied.

Respectfully submitted,

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